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09/883,790	06/18/2001	Matthew Vacek	1470.001US1	2513

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EXAMINER

GRAHAM, MARK S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20040702

Application Number: 09/883,790
Filing Date: 6/18/01
Appellant(s): VACEK ET AL.

Richard E. Billion
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/8/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The amendment after final rejection filed on 10/1/03 has not been entered.

The amendment after final rejection filed on 4/8/04 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2, and 6 as a group; claim 3 as a group; claim 5 as a group; claim 7 as a group; and claim 8 as a group do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,303,917 Uke 4-1994

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Uke. This rejection is set forth in prior Office Action, Paper No. 9.

Claims 3, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uke. This rejection is set forth in prior Office Action, Paper No. 9.

(11) Response to Argument

Appellant's first argument is apparently based on an incorrect premise. The language recited by the appellant as defining claim 1 appears nowhere in the claim. Contrary to appellant's assertion the claim does not require "a sleeve force fit within the hitting surface". All that the claim requires is that a sleeve be positioned within the hitting surface, that both the sleeve and hitting surface be of composite materials; and that the sleeve and hitting surface both be of fibers and resin wherein the first and second resins are different.

As clearly disclosed by Uke, at Col. 4, lines 11-14, the handle (which has an upper portion extending into the hitting surface and is considered the "sleeve" by the examiner) may be made of nylon while the barrel is formed of "softer ABS/nylon alloy." These are "different" resins as required by appellant's claims, even though one constituent of the resin is common to both. Uke makes clear that various different

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resins may be used and that the barrel is to be made of a tougher though softer material. Uke also clearly advises the use of different fibers in the handle and barrel throughout his disclosure.

In response to appellant's further arguments on the point, as can be seen in Fig. 2 or Fig. 6 of Uke, the section which forms the handle portion 22 or 58 extends into the hitting surface, and thus includes a portion which forms a "sleeve positioned within the hitting surface" (in appellant's terminology) which is denoted by Uke as 24 or 60. Thus, Uke discloses the identical structure. The fact that appellant denotes his inner cylindrical member to be a sleeve, while Uke calls the outer cylindrical member the sleeve is irrelevant to what physical structure is actually shown. In both instances the "hitting surface", which is what is claimed by appellant, is inherently the outer surface of the hitting portion, which actually hits the ball. The examiner severely doubts that if another were to come along with appellant's identical structure and denote the inner cylindrical member a shell instead of a "sleeve" the appellant would consider such patentable merely because of the use of different terminology to describe the same structure.

Appellant's next argument concerns the claim 3 rejection. Uke at least at Col. 2, lines 50-65 and Col. 4, lines 19-22 teaches varying the stiffnesses of the two elements as desired by the particular batter. Obviously Uke leaves the exact stiffness up to the ordinarily skilled artisan. In light of such a teaching appellant's recitation of one such possible stiffness being three times the other cannot be considered an unobvious distinction, absent some showing of unexpected results resulting from the particularly

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claimed relative stiffnesses. Appellant has offered no such showing and Appellant has otherwise failed to rebut the prima facie case of obviousness. Nor did appellant request supporting evidence of notice taken by the examiner as to the facts known in the art, in light of Uke, in response to the rejection in the original office action. As such, appellant acquiesced to the notice so taken by the examiner and the current request for evidence supporting official notice is now moot.

“If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. This is necessary because the examiner must be given the opportunity to provide evidence in the next Office action or explain why no evidence is required.” (MPEP 2144.03)

Regarding the other arguments over claim 3 as to the included limitations of claim 1, note the examiner's response to the claim 1 arguments above.

Concerning the arguments as to claims 5, 7, and 8, the appellant has likewise failed to rebut the prima facie case of obviousness. Appellant has merely now suggested that evidence as to facts noted by the examiner in the original office action must now be supplied. Again however, appellant has not seasonably traversed the

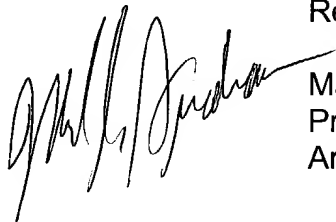
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statements as noted above and thus appellant acquiesced to the notice so taken by the examiner in the original office action. The current request for evidence supporting official notice is now moot.

Regarding the other arguments over claims 5, 7, and 8 as to the included limitations of claim 1, again note the examiner's response to the claim 1 arguments above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark S. Graham
Primary Examiner
Art Unit 3711

MSG
July 2, 2004

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